REMARKS

This Reply is being filed in response to a first Official Action on a second Request for Continued Examination (RCE). The Official Action rejects Claims 1, 6, 7, 9, 11-13, 17-20, 24-29 and 34-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,908 to Pecus et al., in view of U.S. Patent No. 6,157,982 to Deo. The Official Action then rejects the remaining claims, namely Claims 2-5, 14-16, 21-23 and 30-33, as being unpatentable over Pecus, in view of Deo, and further in view of U.S. Patent Application Publication No. 2005/0172326 to Jerding et al. As explained below, however, Applicants respectfully submit that the claimed invention is patentably distinct from Pecus, Deo and Jerding, taken individually or in any proper combination. In view of the remarks presented herein, Applicants respectfully request reconsideration and allowance of all of the pending claims of the present application.

A. Functional Claim Language

Initially, Applicants note that in the Official Action, the Examiner appears to suggest that functional recitations may be ignored in apparatus claims. Official Action of Jan. May 28, 2009, pp. 2-3. However, Applicants respectfully submit that functional language is perfectly acceptable claim language. Section 2173.05(g) of the MPEP defines a functional limitation as "an attempt to define something by what it does, rather than what it is (e.g., as evidenced by its specific structure or specific ingredients)." In this regard, a functional limitation is often used in association with an element to "define a particular capability or purpose that is served by the recited element, ingredient or step." *Id.* More particularly, the Court of Customs and Patent Appeals (predecessor to the Court of Appeals for the Federal Circuit) has held that the limitations "adapted to be fitted," "adapted to be affixed" and "adapted to be positioned," "serve to precisely define present structural attributes of interrelated component parts of the claimed assembly." MPEP § 2173.05(g), *citing In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976) (emphasis added).

Moreover, and more particularly with respect to similar functional language, "configured to," Applicants note that it has been held that an apparatus configured (e.g., programmed) to perform various steps or functions creates a new apparatus. *See In re Alappat*, 33 F.3d 1526,

1545 (Fed. Cir. 1994); and *see id.* at 1569-1570 (Newman, concurring) ("Alappat's rasterizer is an electronic device for displaying a smooth waveform by selective illumination of pixels. The Alappat rasterizer operates by performing a sequence of steps in accordance with instructions that are generated electronically. ... The structure resides in the configuration by which the device operates, as [the majority] has explained, and is independent of how that configuration is provided.") (emphasis added). *See also In re* Noll, 545 F.2d 141, 148 (CCPA 1976) ("[The claimed invention] comprises physical structure, including storage devices and electrical components uniquely configured to perform specified functions through the physical properties of electrical circuits to achieve controlled results. Appellant's programmed machine is structurally different from a machine without that program.").

Applicants therefore respectfully submit that to the extent the claims of the present application include structure positively performing various functions, or include executable instructions for execution by a processor to cause an apparatus to perform various functions, those limitations must be evaluated and considered like any other claim limitation.

B. Claims 1, 6, 7, 9, 11-13, 17-20, 24-29 and 34-39 are Patentable

As indicated, the Official Action rejects Claims 1, 6, 7, 9, 11-13, 17-20, 24-29 and 34-39 as being unpatentable over Pecus, in view of Deo. As previously explained, in contrast to one aspect of the claimed invention, as reflected by independent Claim 12, Pecus does not explicitly or inherently (necessarily, if not explicitly) disclose a remote apparatus configured to at least partially control storage of content in memory of another apparatus based upon the status of the content received from the terminal, and a client expiration time and deletion priority value associated with the content. The first Official Action of this second RCE now concedes that Pecus does not disclose the aforementioned feature of independent Claim 12. Nonetheless, the Official Action alleges that Deo discloses this feature, and that it would have been obvious to one skilled in the art to modify Pecus per Deo to teach the apparatus of independent Claim 12. Applicants respectfully disagree, and submit that even if one could argue Pecus and Deo disclose respective elements of independent Claim 12, there is no apparent reason for the combination of

Pecus and Deo, and the Official Action does not provide sufficient reasoning for their combination.

As clearly explained by the Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d (BNA) 1385 (2007), any finding of obviousness should be based on an apparent reason to combine the prior art, and must be supported by more than mere conclusory statements. In the instant case, the Examiner attempts to support the alleged combination of Pecus and Deo by asserting the following:

> 6. ... *[I]t would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Pecus and Deo in order to decrease the processing burden of a terminal that has less processing power available than a computer it is networked with (Deo, column 2, line 65-column 3, line 4). Further, it is well known that computer networks have a heterogeneous array of computers with varying processing powers, and thus by combining Deo and Pecus, Pecus's system would be better suited if the end node had less processing power than the NOC.*

Official Action of May 28, 2009, p. 4. Applicants disagree with this assessment of Pecus and Deo.

1. Pecus Fails to Disclose its Terminal having Less Processing Power

Even if the system of Deo does generally decrease the processing burden of a processing-limited terminal, the Official Action fails to make the connection between that general benefit of Deo and the particular system of Pecus. In this regard, the alleged benefit of Deo applies to processing-limited devices, but nowhere has the Official Action alleged or explained that the EN of Pecus is a processing-limited device that would benefit from a reduction in its processing burden to the extent that it actually would have been obvious to one skilled in the art to modify Pecus as alleged. In fact, in one passage, Pecus discloses its EN includes a controller that may be implemented by a general purpose computer or workstation, such as a PowerEdge server or Power Macintosh G4 server. *See* Pecus, col. 15, ll. 51-57. And in another passage, Pecus discloses that its EN may include "four dual-733 MHz Intel Pentium III processor servers (e.g., the Power Edge 2450 model server from Dell Computer Corp.), an RF gain amplifier, two satellite routers (e.g., the Enterprise1 from Harmonic Data Systems), a network switch (e.g.,

Model Catalyst 2924 from CISCO Systems), two remote power controllers (e.g., Model AP9211 from APC), a firewall device (e.g., model NetScreen-10 from NetScreen Technologies), multiport keyboard/display controller (e.g., model KVM-8 from APC), and keyboard/mouse/display unit." *Id.* at col. 14, ll. 31-56; and see FIG. 6. These disclosures, and the disclosure of Pecus in general, clearly runs contrary to any suggestion that a reduction in the processing burden on its EN is a concern that would lead one to modify the EN per Deo.

2. Deo's Solution Leads Away from the Alleged Combination

Briefly, Deo discloses a system and method for remotely managing memory in a portable information device from an external computer. As disclosed, the device memory is mapped into a portion of the computer memory to create a virtual device memory therein. To effectuate a change in the device memory, then, a user enters programming changes to be made to the information device. The programming changes alter the virtual device memory within the computer memory, and a memory manager resident in the computer determines what memory transactions are effective to alter the virtual device memory. The computer generates a serial stream of data indicative of memory transactions to effectuate a corresponding alteration of the device memory, and the data is transmitted to the information device to carry out the respective memory transactions and update the device memory.

As disclosed by Pecus its NOC may send a "RequestFileStatus" command to direct the EN to provide the NOC with the status of locally-stored content, but the EN (end node) of Pecus makes decisions as to deleting content from its memory based on parameters including an expiration time and deletion priority value. In the system of Deo, on the other hand, the computer (analogous to the NOC of Pecus) makes decisions as to deleting content from memory of the portable information device (analogous to the EN of Pecus). Instead of making those decisions based on any notification of content status from the portable information device, however, the computer maps the device's memory; thereby negating any need for the computer receiving, from the portable information device, the status of content stored in memory of that device.

At best, then, one could argue that Deo reduces processing burden on its portable information device by mapping memory of that device at the computer, and having the computer control storage of content in memory of that device. But by adding these features (mapping memory of the terminal and controlling storage of content) to the NOC (computer) of Pecus, the EN (portable information device) no longer needs to notify the NOC of the status of content in its memory since the server will already have that information. Thus, it would not have been obvious to one skilled in the art to modify Pecus per Deo to realize an apparatus that receives, from a remote terminal, a status of content stored in memory of the terminal, and that sends one or more instructions to the terminal based on that status to thereby control storage of content in memory of the terminal.

Applicants therefore respectfully submit that independent Claim 12, and by dependency Claims 13-18, is patentably distinct from Pecus. Independent Claims 1, 19, 29 and 39 recite subject matter similar to that of independent Claim 12, including the aforementioned controlling storage of content at a terminal based on multiple parameters associated with the content, and sending instructions from a remote network entity or apparatus to control storage of such content. Thus, Applicants also respectfully submit that independent Claims 1, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 20-28 and 30-38, are also patentably distinct from Pecus, taken individually or in any proper combination, for at least the reasons given above with respect to independent Claim 12.

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 1, 6, 7, 9, 11-13, 17-20, 24-29 and 34-39 as being unpatentable over Pecus, in view of Deo is overcome. In addition to the foregoing reasons, Applicants respectfully submit that various ones of dependent Claims 2-7, 9, 11, 13-18, 20-28 and 30-38 recite features further patentably distinct from Pecus and Deo, taken individually or in any proper combination. Examples of such dependent claims, including Claims 7, 25 and 35, are explained below.

3. Dependent Claims 7, 25 and 35

As to dependent Claims 7, 25 and 35, neither Pecus nor Deo, taken individually or in any proper combination, teach or suggest a server expiration time according to which content may be

deleted from a network entity or apparatus (separate from the terminal with content associated with a client expiration time according to which locally-stored content may be deleted). The Official Action cites Pecus for allegedly disclosing this feature, with the Official Action alleging that the NOC of Pecus corresponds to the recited network entity. Applicants respectfully submit, however, that nowhere does Pecus disclose its NOC monitors an expiration time (server expiration time) of its locally-stored content, and deletes content having an expired expiration time (server expiration time). Rather, Pecus only discloses deleting content locally-stored by its EN, and based upon a single expiration time (allegedly corresponding to the recited client expiration time). Thus, not only does Pecus not teach or suggest its alleged network entity deleting locally-stored content based upon monitoring an expiration time, Pecus does not teach or suggest multiple expiration times associated with a piece of content. That is, Pecus does not teach or suggest both a client expiration time (from which content may be deleted from memory of a terminal), and a server expiration time (from which content may be deleted from the network entity that sends the content to the terminal), as recited by dependent Claims 7, 25 and 35.

C. Claims 2-5, 14-16, 21-23 and 30-33 are Patentable

The Official Action rejects Claims 2-5, 14-16, 21-23 and 30-33 as being unpatentable over Pecus, in view of Deo, and further in view of Jerding. As explained above, independent Claims 1, 12, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 13-18, 20-28 and 30-38, are patentably distinct from Pecus and Deo, taken individually or in any proper combination. Applicants respectfully submit that Jerding does not cure the deficiencies of Pecus and Deo. That is, even considering Jerding, none of Pecus, Deo or Jerding, taken individually or in any proper combination, teaches or suggests the aforementioned controlling storage of content at an apparatus based on multiple parameters associated with the content, and sending instructions from another, remote apparatus to control storage of such content, as per independent Claims 1, 12, 19, 29 and 39. Applicants therefore respectfully submit that independent Claims 1, 12, 19, 29 and 39, and by dependency Claims 2-7, 9, 11, 13-18, 20-28 and 30-38, are patentably distinct from Pecus, in view of Deo, and further in view of Jerding.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 2-5, 14-16, 21-23 and 30-33 as being unpatentable over Pecus, in view of Deo, and further in view of Jerding is overcome. In addition to the foregoing reasons, Applicants respectfully submit that various ones of dependent Claims 2-7, 9, 11, 13-18, 20-28 and 30-38 recite features further patentably distinct from Pecus and Deo, taken individually or in any proper combination. Examples of such dependent claims, including Claims 3-5, 14-16, 21-23 and 31-33, are explained below.

1. Dependent Claims 3, 4, 14, 15, 21, 22, 31 and 32

In contrast to dependent Claims 3, 14, 21 and 31, from which Claims 4, 15, 22 and 32 depend, nowhere does Pecus teach or suggest determining content having an exceeded client expiration time, and from that content, identifying content having the highest deletion priority value (thereby identifying content that is both expired and has the highest deletion priority value). That is, following the assertions in the Official Action, nowhere does Pecus teach or suggest determining expired content, and from that content, identifying content having the highest forced deletion flag (thereby identifying content that is both expired and has the highest forced deletion flag). Instead, Pecus treats its expiration time and forced deletion flag separate from one another in deciding whether to delete content. More particularly, Pecus discloses deleting all of the expired content or content marked for forced deletion; or first deleting content marked for forced deletion, and then expired content.

2. Dependent Claims 5, 16, 23 and 33

Dependent Claims 5, 16, 23 and 33, which depend from respective ones of Claims 3, 14, 21 and 31 by way of respective ones of Claims 4, 15, 22 and 32, recite sending or receiving instruction(s) to delete content having an exceeded client expiration time, and from any remaining content, delete content having the highest deletion priority value, which is also absent from Pecus, Deo and Jerding, taken individually or in any proper combination. Pecus does disclose deleting content marked for forced deletion (alleged deletion priority value), and then expired content (alleged exceeding client expiration time) – i.e., first forced deletion, then

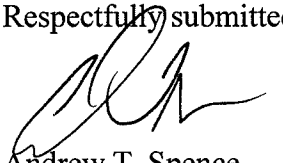
expired. But even given this disclosure, Pecus does not teach deleting expired content, and then content having the highest deletion priority – i.e., first expired, then highest deletion priority value, similar to Claims 5, 16, 23 and 33.

CONCLUSION

In view of the remarks presented above, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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